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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,728	07/31/2001	Tatsuo Yoshino	0905-0264P	1252
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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			QIN, YIXING	
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			2625	

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/917,728

Applicant(s)

YOSHINO, TATSUO

Examiner

Yixing Qin

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-7,9-13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-7,9-13 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

In response to applicant's amendment received 3/21/06, all requested changes have been entered.

### ***Response to Arguments***

Applicant's arguments filed 3/21/06 have been fully considered but they are not persuasive. The argument is that although the Fredlund and Motegi references together disclose two types of IDs (image ordering and print commanding), neither discloses the generation of these IDs in accordance with the acceptance of the image data. The Examiner respectfully disagrees. Fredlund '215 discloses in column 3, lines 32-36 that IDs are sent along with a digital image. While this is not explicit that the IDs are created when the digital image file is accepted, but it would be obvious that such an ID would be created when the file is accepted. Else, why would one create an ID without associating it to a file? Also, in Motegi, column 3, lines 45-50 that the network server receives the print request signal, with image data, ... and then registers the job number and password with the image data sent from the network computer. So, this does indeed suggests that a print commanding ID is generated according to accepted image data.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 2-4, 7,9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (U.S. Patent No. 5,666,215 – “Fredlund ‘215”) in view of Motegi (U.S. Patent No. 6,307,640)

**Claims 2 and 16.** Fredlund ‘215 discloses a server computer capable of being connected to a communication terminal comprising a display device capable of displaying an image such that they can communicate with each other through a network, comprising:

an image database storing image data; (column 4, lines 46-54 that a client computer can access images from a storage device 28 through a communication channel. One can see in figure 1B that this is a mass storage device - e.g. a database.)

an image data transmission device for transmitting to said communication terminal the image data stored in said image database in response to an image transmission request from said communication terminal; (column 6, lines 50-53)

a storage device storing order information transmitted from said communication terminal and related to prints of an image represented by the image data transmitted by said image data transmission device; (the server - i.e. computer 260 would inherently have a storage device, such as a hard disk, for storing image information (see also column 7, lines 18-21).

a controller controlling a printer so as to print the image represented by the image data specified on the basis of the order information stored in said storage device in response to the print command from said communication terminal; (column 7, lines 18-21)

image data registration acceptance means for accepting the registration of the image data to be stored in the image database; and (column 4, lines 33-35)

first ID generation means for generating an image ordering ID (column 3, lines 32-36)

The Fredlund '215 reference discloses the use of IDs, but not a print commanding ID, for photofinishing.

It does not explicitly disclose "a print commanding ID in correlation with the accepted image data in response to the acceptance of the image data by the image data registration acceptance means and the print command transmitted from the communication terminal including the print commanding ID, and said printer controller controlling the printer so as to print an image represented by the image data correlated with the print commanding ID in response to the print command from the communication terminal.

However, Motegi reference, discloses in Fig. 3 item S2, the registering of a job number. This can be a print commanding ID since it designates which job to print. Motegi, again, discloses in Fig. 3, items S5 and S6, the printing of an image according to a job number.

Fredlund '215 and Motegi are combinable because both in the art of photofinishing.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included an additional print commanding ID function

The motivation would have been to allow more control over when an order is to be printed.

Therefore, it would have been obvious to combine Fredlund '215 and Motegi to obtain the invention as specified.

the image transmission request transmitted from the communication terminal including said image ordering ID, said image data transmission device transmitting to said communication terminal the image data correlated with the image ordering ID in response to the image transmission request from the communication terminal. (column 4, lines 46-54)

**Claim 3.** Fredlund '215 discloses a server computer according to claim 2, wherein said order information includes information related to the desired number of prints of the

image represented by the image data specified by said order information. (column2 , lines 37-40).

**Claim 4.** Fredlund '215 discloses a server computer according to claim 3, further comprising means for calculating a print charge on the basis of the information related to said desired number of prints; and print charge transmission means for transmitting to said communication terminal data representing the calculated print charge. (column 2, lines 42-44 and column 6, lines 27-28)

**Claim 7.** Fredlund '215 discloses a server computer according to claim 2, further comprising means for accepting from said communication terminal the transmission of display device type information related to the type of the display device in the communication terminal, said image data transmission device converting the image data stored in said image database into image data adaptable to the display device in the communication terminal in accordance with the display device type information and transmitting the image data to the communication terminal. (column 4, lines 46-54 that images are transferred from a server to a CRT. The server sends low-resolution images (line 49) to the CRT to display. These images have already been converted in advance; see column 3, lines 64-67 and column 4, lines 1-35. )

**Claim 9.** Fredlund '215 discloses a server computer according to claim 1, further comprising:

password generation means for respectively generating an image ordering password corresponding to the image ordering ID and a print commanding password corresponding to the print commanding ID which are generated by the first ID generation means; (column 3, lines 34-35 of Fredlund '215. Again, from claim 8 above, the Motegi reference addressed the print commanding ID).

The Fredlund '215 reference discloses a method for photofinishing.

It does not explicitly disclose "image data transmission judgment means for judging whether or not the image data should be transmitted to said communication terminal on the basis of the image ordering ID and the image ordering password; and print judgment means for judging whether or not the printer should be controlled so as to print the image represented by the image data on the basis of the print commanding ID and the print commanding password,"

However, Motegi discloses in Fig. 3 items S8-S10 that there is a judgment of whether a job number/password combination matches with that stored on the server. It would be obvious to apply this to the customer identification number in Fredlund '215. Also, it would be obvious that if inappropriate identification is entered in the Fredlund '215 invention, the images would not be transferred from the server to the client. The Examiner would like to note that the checking of passwords for printing authentication is known in the art.

Fredlund '215 and Motegi are combinable because both are in the art of photofinishing



Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a password judging mechanism in Fredlund '215's invention to judge whether an image should be transmitted and printed.

The motivation would have been to enable printing authentication to make sure that a user has the proper rights to print certain images.

Therefore, it would have been obvious to combine Fredlund '215 'and Motegi to obtain the invention as specified.

the image transmission request transmitted from the communication terminal further including the image ordering password, and the image data transmission device transmitting the image data to the communication terminal when it is judged that the image data can be transmitted by the image data transmission judgment means on the basis of the image ordering ID and the image ordering password, (The image transmission was discussed above in claim 2 - see column 4, lines 46-54 of Fredlund '215.)

the print command transmitted from the communication terminal further including the print commanding password, and the printer controller controlling the printer so as to print the image represented by the image data in a case where it is judged that printing is possible by the print judgment means on the basis of the print commanding ID and the print commanding password. (again, the secondary reference, Motegi discloses in Fig. 3 item S8, S9 and S11 the printing of an image based upon a proper job number/password combination.)

II. Claim 5 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (U.S. Patent No. 5,666,215 – “Fredlund ‘215 “) in view of Moteji (U.S. Patent No. 6,307,640) and further in view of Tamura et al (U.S. Patent No. 6,771,896 – “Tamura”)

**Claim 5.**

The Fredlund ‘215 reference discloses a photofinishing method.

It does not explicitly disclose “a server computer according to claim 2, further comprising means for calculating at least a planned completion date for the prints of the image by the printer controlled by said printer controller in response to the print command from said communication terminal, and planned completion date transmission means for transmitting to said communication terminal data representing the calculated planned completion date.”

However, Tamura, discloses in column 12, lines 1-8 that an electronic camera (i.e. client) can receive date of completion information from a photofinisher (i.e. server). A date of completion would have to be calculated before it would be sent.

Fredlund ‘215 and Tamura are combinable because both references are in the art of photofinishing

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a planned completion date in Fredlund ‘215’s invention.

The motivation would have been to let an user know when he/she can have the prints ready.

Therefore, it would have been obvious to combine Fredlund '215 and Tamura to obtain the invention as specified.

III. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (U.S. Patent No. 5,666,215 – "Fredlund '215 ") in view of Motegi (U.S. Patent No. 6,307,640) and further in view of Ueda et al (U.S. Patent No. 6,429,923 – "Ueda")

**Claim 6.**

The Fredlund '215 reference discloses a photofinishing method.

It does not explicitly disclose "a server computer according to claim 2, further comprising order condition information transmission means for transmitting to said communication terminal order condition information represented on the basis of the order information stored in said storage device in response to an order condition confirmation request from the communication terminal."

However, Ueda, discloses in column 44 lines 17-35 that a client computer can make a server computer transmit order contents information (line 20). One would understand that this information is stored in the hard disk of the server.

Fredlund '215 and Ueda are combinable because both references are in the art of photofinishing

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have to have a order transmission mechanism for transferring order content information.

The motivation would have been to let a user verify his/her order.

Therefore, it would have been obvious to combine Fredlund '215 and Ueda to obtain the invention as specified.

**IV.** Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (U.S. Patent No. 5,666,215 – “Fredlund '215”) in view of Motegi (U.S. Patent No. 6,307,640) and further in view of Chui et al (U.S. Patent No. 6,657,702).

**Claim 10.**

The Fredlund '215 and Motegi references disclose two types of IDs for printing, but not another one as claimed.

It does not explicitly disclose “a second ID generation means for generating a member specifying ID in correlation with the image ordering ID generated by the first ID generation means, said member specifying ID, together with the order information, being transmitted from the communication terminal, and the storage device storing the received order information and the member specifying ID with both correlated with each other.”

However, the tertiary reference, Chui discloses in Fig. 6 and column 18, lines 25-47 the use of a data table to keep member information. Lines 39-43 discloses that

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virtually any pertinent information can be stored. This makes it obvious that the member information can be stored with ordering information. Chui further discloses in column 16, lines 49-66 the association of image with a particular alias (i.e. member ID) – that is the user provides member ID information along with images associated with that member ID.

All three references are combinable because they are all in the art of photofinishing.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included member information.

The motivation would be to allow various groups access to different and/or specific images on a server based upon the credentials of that group.

Therefore, it would have been obvious to combine all three references to obtain the invention as specified.

V. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (U.S. Patent No. 5,666,215 – “Fredlund ‘215”) in view of Motegi (U.S. Patent No. 6,307,640) and further in view of Fredlund et al (U.S. Patent No. 6,154,295 – “Fredlund ‘295”)

**Claim 11.**

The Fredlund '215 and Motegi references disclose two types of IDs for printing, but not another one as claimed.

They do not explicitly disclose "a means for erasing from the image database the image data stored in the image database when a predetermined set time period has elapsed from a date for acceptance of the image data by the image data registration acceptance means."

However, the tertiary reference, Fredlund '295 teaches this in column 3, lines 47-57. Also note column 4, lines 43-47.

All three references are combinable because they are all in the art of photofinishing.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a feature in Fredlund '125 to have the server erase images after they have been stored there for a certain amount of time.

The motivation would be to enable the server to free up space since the passing of a period time without any orders on that images is a good indication that the customer does not want to make any orders of those images.

Therefore, it would have been obvious to combine all three references to obtain the invention as specified.

**Claim 12.** As mentioned in claim 11 above, Fredlund '295 discloses in column 4, lines 43-47 that files would be automatically deleted after a predetermined period of time, which can be a month as mentioned in column 3, lines 47-53

**Claim 13.** As mentioned in claim 11 above, Fredlund '295 discloses in column 3, lines 56-57 that if any service is ordered (can read on printing), then the maintenance of the digital negative is extended.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YQ

  
Twyler M. Lamb  
Supervisory Patent Examiner